

Docket No. 031896-002000 (AM100927)

Patent

REMARKS

In response to the May 23, 2005 Office Action, Applicants hereby elect, with traverse, claims 1-8 and gene GPR49 (i.e., Invention Group 17) for prosecution on the merits. Gene GPR49 encodes SEQ ID NO:84 and is depicted in Table 3 on page 16 of the specification. In addition, Applicants elect, with traverse, SEQ ID NO:18258 in response to the Election of Species requirement on pages 4-5 of the Office Action. SEQ ID NO:18258 is described in Table 7 and represents a siRNA sequence directed to gene GPR49.

Claims 1-20 are pending. By this amendment, Applicants have withdrawn, with traverse, claims 9-20. Applicants reserve the right to pursue the withdrawn claims in a divisional or continuation application(s).

On pages 2-4, the Office Action requires Applicants to elect one invention from Groups 1-838. On pages 4-5, the Office Action further requires Applicants to select one species from RNAi and antisense sequences described in Table 7, antibodies directed to the protein products of genes depicted in Tables 1-5, and inhibitors of the genes listed in Tables 1-5 and their expression products.

Applicants hereby elect, with traverse, claims 1-8 and gene GPR49 (i.e., Group 17) for prosecution on the merits. Gene GPR49 encodes SEQ ID NO:84. Although the election of claims 1-8 and gene GPR49 renders the Election of Species requirement moot, Applicants hereby elect, with traverse, SEQ ID NO:18258.

MPEP §803.04 states that "to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application." MPEP §803.04 also states that "[i]t has been determined that normally ten sequences constitute a reasonable number for examination purposes." (Emphasis added). Accordingly, Applicants respectfully submit that the Examiner's requirement to elect only one gene from Tables 1-5 is improper. Reconsideration of the restriction requirement is, therefore, respectfully requested.

In addition, MPEP § 803 states "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Without agreeing or disagreeing with the contention that Groups 1-837 are distinct or independent inventions, Applicants respectfully submit that the search and examination of Groups 1-837 do not

Docket No. 031896-002000 (AM100927)
Patent

impose a serious burden upon the Examiner. For instance, all of the claims in Groups 1-837 are directed to colon cancer genes and uses thereof. Therefore, Applicants respectfully submit that the search and examination of Groups 1-837 would not create any undue burden upon the Examiner. Reconsideration of the restriction/election requirement is, therefore, respectfully requested.

Furthermore, Applicants respectfully point out that a total of 63 genes are listed in Tables 1-5, which encode SEQ ID NOS: 64-126. Accordingly, Applicants respectfully submit that the Office Action improperly limits Applicants' election to SEQ ID NOS: 68-126.

Docket No. 031896-002000 (AM100927)
Patent

CONCLUSION

Although Applicants believe that no fee is due for the instant response, the Commissioner is hereby authorized to charge any payment deficiency to deposit account number 19-2380 referring to attorney docket number 031896-002000.

Should the Examiner have any questions that would facilitate further prosecution or allowance of this case, the Examiner is invited to contact Applicants' representative designated below.

Respectfully submitted,



Raymond Van Dyke
Reg. No. 34,746

Date: June 23, 2005

Nixon Peabody LLP
Suite 900
401 9th Street, N.W.
Washington, D.C. 20004-2128
Tel: (202) 585-8250